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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/041,571
Filing Date: January 10, 2002
Appellant(s): MYERS ET AL.

Sean L. Ingram
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed August 23, 2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-23 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

Art Unit: 2645

2002/0130904

Becker et al

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilcox et al.

US Patent 6,404,856 in view of Becker et al. US Patent 2002/0130904.

Regarding claims 1,12 and 18, Wilcox teaches a system and a processor readable medium having process readable code embodied therein for annotating audible messages that are received by a subscriber of a unified communications service network, (abstract; col. 5, line 63-col. 6, line 6), the system comprising:

a message presentation form that enables the subscriber to access audible messages, (fig. 3; col. 4, lines 9-31; col. 6, lines 31-53), the message presentation form further comprising: an audible message player that enables playback of an audible message, (col. 1, line 62-col. 2, line 11; col. 4, lines 32-45); and

a notes field that enables the subscriber to annotate the audible message during playback of the audible message, (col. 4, lines 53-col. 5, line 17; fig. 3; col. 2, lines 43-44); and

enabling the subscriber to annotate the audible message using the private notes field, (col. 4, line 53-col. 5, line 17).

Wilcox does not specifically teach a message forwarder that enables forwarding of audible messages and annotations at the option of the subscriber.

In the same field of endeavor, Becker teaches that it was well known in the art to have a message forwarder that enables forwarding of audible messages (paragraphs 0047 and 0089) to

Art Unit: 2645

other recipients and wherein annotations are forwarded at the option of the subscriber, (paragraphs 0051 and 0056).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Wilcox by allowing a user to forward annotated messages as suggested by Becker so that a user can forward messages to other users and so that information can be shared among said users.

Regarding claims 2,8,13 and 19, Wilcox teaches a search tool that enables search and retrieval of audible messages based, at least in part, upon annotations in the notes field, (col. 6, lines 31-63).

Regarding claims 5,16 and 22, Wilcox teaches wherein the message presentation form further comprises: a subject field that enables input of a subject heading for the audible message, (col. 4, line 62-col. 5, line 17; col. 6, line 31-63).

Regarding claims 3,4,6,9,10,11,14,15,17,20,21 and 23, While Wilcox teaches of annotating audible messages and a graphical user interface enables a user to input a subject heading into a subject field for the audible message, (col. 4, line 62-col. 5, line 17; col. 6, line 31-6), Wilcox does not specifically teach of forwarding annotations in the notes field or providing an option of forwarding the subject heading.

In the same field of endeavor, Becker teaches that it was well known in the art to have a message forwarder that enables forwarding of audible messages to other recipients and wherein annotations in the notes field are forwarded, (paragraphs 0051 and 0056) or wherein annotations in the notes field are not forwarded, (paragraphs 0051 and 0056). Becker further teaches wherein

Art Unit: 2645

the message forwarder enables forwarding of audible message with the subject heading, (paragraphs 0051,0056 and 0089).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Wilcox by allowing a user to forward annotated messages as suggested by Becker so that a user can forward messages to other users and so that information can be shared among said users.

Regarding claim 7, Wilcox teaches a system for annotating audible messages that are received by a subscriber of a unified communications service network, (abstract; col. 5, line 63-col. 6, line 6), the method comprising:

presenting the subscriber with a graphical user interface having a message presentation form that enables the subscriber to access audible messages, (fig. 3; col. 4, lines 9-31; col. 6, lines 31-53);

providing an audible message player associated with the graphical user interface that enables playback of an audible message, (col. 1, line 62-col. 2, line 11; col. 4, lines 32-45); and

providing a notes field associated with the graphical user interface that enables the subscriber to annotate the audible messages during playback of the audible message, (col. 4, lines 53-col. 5, line 17; fig. 3); and

Wilcox does not specifically teach a message forwarder that enables forwarding of audible messages and annotations at the option of the subscriber.

In the same field of endeavor, Becker teaches that it was well known in the art to have a message forwarder that enables forwarding of audible messages (paragraphs 0036,0047 and

Art Unit: 2645

0089) to other recipients and wherein annotations are forwarded at the option of the subscriber, (paragraphs 0051 and 0056).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Wilcox by allowing a user to forward annotated messages as suggested by Becker so that a user can forward messages to other users and so that information can be shared among said users.

(11) Response to Argument

Independent claims 1,7,12 and 18

1. Applicant contends that that Wilcox does not teach or suggest a message forwarder that enables forwarding of any message, wherein the messages, indexed or not indexed, are forwarded at the option of the subscriber. The Examiner respectfully disagrees.

The Examiner notes that the Office Action never indicated that Wilcox taught of a message forwarder, however, in view of the 103 rejection, the Examiner believes that Wilcox at least suggests of a “message forwarder” for forwarding the message. As suggested in col. 6, lines 47-53, a user in the Wilcox Patent has a desire to have a previous telephone conversation (message) with its associated properties and notemarks (annotations) to be heard by a second party during a telephone call so that comments from a previous conversation can be shared. The Examiner believes that this provides a suggestion to enable one of ordinary skill in the art to provide a system that allows the message to be heard (forward) to another party.

2. Applicant contends that Becker does not teach or suggest that the annotation may be included during playback of the “entire messaging session”. Rather Becker discloses that the

Art Unit: 2645

decision to annotate or not to annotate the “entire messaged session” is made at the time the entire messaging session is to be forwarded. The Examiner respectfully disagrees.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant repeatedly argues that Becker does not disclose annotating a message during playback of the entire messaging session. However, the Examiner did not rely upon Becker for this teaching. Wilcox, the primary reference, was relied upon for this teaching. Applicant have not made any arguments as to whether or not Wilcox teaches this limitation and only relied upon Becker for this limitation. As the pending claims state, the requirement is to have a notes field that enables the subscriber to annotate the audible messages during playback of the audible message”, which as stated in the rejection of the claims, Wilcox teaches of enabling the subscriber to annotate the audible message during playback of the audible messages in a notes field, as shown in at least col. 2, lines 43-44 and fig. 3. The second requirement of the claims is to have a message forwarder that enables forwarding of audible messages, wherein the annotation associated with the audible messages are forwarded at the option of the subscriber. Becker was relied upon to teach that it was well known in the art to have a “message forwarder” and to send annotations and messages using the forwarder. The combination of this teaching from Becker into the system of Wilcox along with the motivation to combine from Wilcox will provide for the notes and message of Wilcox, in which the notes were noted during playback of a message to be forwarded to a second party at the option of the user. Thus the Examiner believes

Art Unit: 2645

and maintains that the teaching of Wilcox and Becker teach of each limitation and provides motivation for using a message forwarder for forwarding the message.

3. Applicant also contends that the Examiner has not provided any support for his position that Becker discloses a message forwarder that enables forwarding of audible message and annotations at the option of the subscriber. Examiner respectfully disagrees.

The Examiner believes that the above statement by Applicant contradicts and earlier statement in which the Applicant state in page 5, lines 12-13 of the Appeal Brief “Rather, Becker discloses the decision to annotate or not to annotate the “entire messaging session” is made at the time the entire messaging session is to be forwarded”. Hence, it seems that Becker at least from Applicants statement teaches of a message forwarder for forwarding message and an annotation at the option of the subscriber.

Furthermore, as shown in the office action Becker teaches of allowing the user to determine whether or not they are going to sent the annotations. This is emphasized in paragraphs 0056 and 0081 in which forward command 143 is used for forwarding message with or without annotation to another user, hence audible messages (described in paragraphs 0005, 0047 and 0089 of Becker and by Wilcox as shown above) and annotations are forwarded at the option of the user.

4. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5

Art Unit: 2645

USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Wilcox does not specifically teach of a message forwarder but suggests of sending the message with annotations to a second party so that the user's can share information. Wilcox further teaches that one would have been motivated to sent the message so that audio data and notemarks from a previous conversation can be shared, (col. 6, lines 47-53). Becker teaches that it was well known in the art to have a message forwarder that send messages to a second party with annotations at the option of the user. Therefore, Wilcox provides a sufficient suggestion to use a message forwarder.

5. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

As stated above at least Wilcox cites a motivation in that one of ordinary skill in the art would want to forward messages to other parties so that the user can share information with a plurality of people, (col. 6, lines 47-53). The Examiner believes that either from references themselves or from one of general skill in the art would have been motivated to use the suggest generally available in the teaching of the prior art.

6. In response to applicant's argument that Becker is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be

Art Unit: 2645

reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the art reference Becker is in the same field of endeavor, since Becker is related to annotating audible messages and forwarding audible messages as well as using a computer based telephone interface for forwarding the messages. Applicants instant invention, like Becker, is also directed to annotations, with text and voice messages using a computer based telephone interface. Therefore, Becker is in the same field of endeavor since both Becker and Applicants' instant invention both involve a telephony-based system and annotating using text.

Dependent Claims 2, 8, 13, and 19

Applicant contends that Wilcox does not disclose searching annotation in a notes field. The Examiner respectfully disagrees.

As stated in the Office Action Wilcox teaches of searching notemarks and properties having a specified keyword, (col. 6, lines 39-44). Wilcox teaches also in col. 2, lines 43-52 that the user takes notes while recoding the audio data of a telephone call. Attributes of the call which comprise of at least properties and keywords are used to index the data for subscriber retrieval. Wilcox further states that the subscriber applies properties and notemarks to the audio data for subsequent retrieval. Therefore, Wilcox searches for annotations in the notes field since the user can subsequently retrieve the annotations.

Dependent claims 3, 9, 14 and 20

Applicant contends that Becker does not disclose that the message forwarder is adapted to forward annotations in the notes field. The Examiner respectfully disagrees.

Art Unit: 2645

Becker as discussed in the office action teaches in paragraphs 0051 and 0056 of forwarding message with or without annotations. Furthermore, as stated above, a statement by Applicant in page 5, lines 12-13 of the Appeal Brief states “Rather, Becker discloses the decision to annotate or not to annotate the “entire messaging session” is made at the time the entire messaging session is to be forwarded”, thus the Examiner believes that Becker teaches of a message forwarder adapted to forward annotations in the notes field.

Dependent claims 4,10,15 and 21

Applicant contends that Becker does not disclose that the message forwarder is adapted not to forward annotations in the notes field. The Examiner respectfully disagrees.

As stated above by the Examiner Becker specifically states in paragraphs 0051 and 0056 of sending the message with or without annotations.

Dependent claims 5,11,16 and 22

Applicant contends Wilcox does not teach a subject field that enables input of a subject heading for the audible messages. The Examiner respectfully disagrees.

The “properties” of Wilcox represent data that pertains to the subject of the audible messages as shown in col. 4, lines 19-31. This is also shown in col. 1, line 62 - col. 2, line 11 in which Wilcox states that properties are used to index the audio data based on the content of the audio data.

Dependent claims 6,17 and 23

Applicant contends that Becker does not disclose a subject heading nor the option to forward subject headings. The Examiner respectfully disagrees.

Art Unit: 2645

Becker teaches of forwarding the entire messaging session as shown in paragraph 0051, 0056 and 0089. Furthermore, since at least Wilcox teaches of using subjects for the audible message and since Becker is used to teach of forwarding entire message sessions, the combination would result is a system that forwards the subject, audible message and notemarks to another party at the option of the user so that information can be shared among others.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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O.E.

November 29, 2004

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